Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TIMOTHY ALAN DIETZ

Appeal No. 2003-0726
Application 09/456,076

ON BRIEF

Before KRASS, RUGGIERO, and NAPPI, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1-29, which are all of the claims pending in the present application.

The claimed invention relates to providing indexed web page contents to a search engine database. A web page is accessed by

a user and a temporary copy of the web page is stored on the user accessible device which accesses the web page. Indexing information corresponding to the content of the accessed web page is automatically recorded at the user accessible device, the indexing information being thereafter transmitted from the device to a remote storage device which provides the search engine database.

claim 1 is illustrative of the invention and reads as follows:

1. A method for providing indexed web page contents to a search engine database, said method comprising the steps of:

providing user access to a web page from a temporary copy of said web page which is stored on a device which accesses said web page and which is accessible to said user; in response to each user request for a web page;

automatically recording indexing data at said device from said temporarily stored copy of said accessed web page, wherein said indexing data corresponds to contents of said accessed web page; and

transmitting said indexing data from said device to a remote data storage device which provides a search engine database.

The Examiner relies on the following prior art:

Rosenzweig US 2001/0023476 A1 Sep. 20, 2001
(Published U.S. Patent App.) (effectively filed Aug. 21, 1997)

Claims 1-29, all of the appealed claims, stand finally rejected under 35 U.S.C. § 102(e) as being anticipated by Rosenzweig.

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the Briefs[1], the final Office action, and Answer for the respective details.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner and the evidence of anticipation relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellant's arguments set forth in the Briefs along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the Rosenzweig reference does not fully meet the invention as set forth in claims 1-29. Accordingly, we reverse.

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital

[1] The Appeal Brief was filed July 18, 2002 (Paper No. 9). In response to the Examiner's Answer dated August 14, 2002 (Paper No. 10), a Reply Brief was filed October 22, 2002 (Paper No. 12), which was acknowledged and entered by the Examiner as indicated in the communication dated October 30, 2002 (Paper No. 13).

Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

With respect to each of the appealed independent claims 1, 9, 11, 18, 21, and 26, the Examiner attempts to read the various limitations on the disclosure of Rosenzweig. In particular, the Examiner directs attention (page 3, final Office action mailed May 7, 2002, Paper No. 6) to paragraphs 9, 49, 58-72, 77, and 78 of the disclosure of Rosenzweig.

Appellant's arguments in response assert a failure of Rosenzweig to disclose every limitation in the appealed claims as is required to support a rejection based on anticipation. After reviewing the Rosenzweig reference in light of the arguments of record, we are in ultimate agreement with Appellant's position as expressed in the Briefs.

At the outset, however, we note that we do not agree with Appellant's arguments directed to the claimed feature of automatically recording indexing data at a user accessible device from a temporarily stored copy of an accessed web page "wherein said indexing data corresponds to contents of said accessed web page." In Appellant's view (Brief, pages 6 and 7; Reply Brief, page 2), the caching schemes disclosed by Rosenzweig which store

temporary copies of a web page dependent on criteria such as frequency or duration of access to a particular web page, do not index data which corresponds to the content of an accessed web page as claimed.

We agree with the Examiner, however, that the embodiment disclosed by Rosenzweig in which a particular web page provides indexing to other locations within the same web page satisfies the automatic indexing requirement of the appealed claims. As illustrated in Figure 4 of Rosenzweig with accompanying disclosure at paragraph 57, the cached copy of the accessed web page 400 has links 410 at the top of the page which provide an index to other locations within the web page, these indexing links clearly corresponding to the contents of the web page.

While we found the above argument of Appellant to be without merit, we do find to be persuasive Appellant's arguments (Brief, page 7; Reply Brief, page 2) directed to the claimed feature, present in all of the independent claims, of "transmitting said indexing data from said device to a remote data storage device which provides a search engine database." We recognize that the Examiner has expanded his position on this claimed feature by directing attention to paragraphs 49 and 91 in Rosenzweig (Answer, page 4). We find nothing, however, in either of these paragraphs, or elsewhere in Rosenzweig, that would support the

Examiner's position. Rosenzweig, at paragraph 49, merely indicates that web pages may have been accessed as a result of the use of an Internet search engine, while paragraph 91 suggests that, instead of caching web pages on a local client computer, caching may be provided by a network server. It seems apparent to us that merely storing web pages on a network server rather than a client computer does not satisfy the claimed requirement of transmitting indexing data from the user accessible device, i.e., Rosenzweig's client computer, to the remote data storage device (Rosenzweig's network server) which provides a search engine database.

In view of the above discussion, in order for us to sustain the Examiner's rejection, we would need to resort to impermissible speculation or unfounded assumptions or rationales to supply deficiencies in the factual basis of the rejection before us. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968), rehearing denied, 390 U.S. 1000 (1968). Accordingly, since all of the claim limitations are not present in the disclosure of Rosenzweig, we do not sustain the Examiner's 35 U.S.C. § 102(e) rejection of appealed independent claims 1, 9, 11, 18, 21, and 26, nor of claims 2-8, 10, 12-17, 19, 20, 22-25, and 27-29

dependent thereon. Therefore, the decision of the Examiner rejecting claims 1-29 is reversed.

REVERSED

ERROL A. KRASS Administrative Patent Judge	)	
JOSEPH F. RUGGIERO Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
ROBERT NAPPI Administrative Patent Judge	)	

JFR/dal

Bracewell & Patterson LLP
PO Box 969
Austin TX 78767